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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,878	09/11/2003	Shridhar P. Joshi	47079-00225USPT	5010

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JENKENS & GILCHRIST, P.C.
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CHICAGO, IL 60606

EXAMINER

MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/659,878

Applicant(s)

JOSHI ET AL.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/05, 12/04, 5/04, 1/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements submitted February 25th, 2005; December 6th, 2004; May 27th, 2004; and January 5th, 2004 have been considered. A copy of each respective statement with the Examiner's notation indicating their consideration has been attached for the Applicant's record.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **14**, and **25** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim **14** defines a first game payout as "bonus game jackpot" while the parent claim **12** defines the same element as "...the first payout when a first randomly selected outcome is achieved in the basic game..."

There is a contradiction in the claims wherein the payout is first determined in accordance with a base game outcome in claim **12** and then in dependent claim **14** the payout is referred to as a bonus game jackpot. The claim defines a payout associated with a bonus game while the claim has not set forth any structure related to a bonus game and previously assigned the same element to a base game outcome.

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Claim 25 incorporates the same contradiction and accordingly will additionally require appropriate correction.

The language of claims 14 and 25 "a bonus game jackpot", has been interpreted as "a game bonus jackpot" for the purposes of this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-8, 11-22, and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Celona (US 5,564,700).

Claims 1, 3, 8, 12-14, and 24-26: Celona teaches a method of playing a wagering game including a base game with a randomly selected game outcome (Col 4:28-34) and allowing the player to present a base wager and in addition thereto an additional wager amount in the for of a max bet (Col 3:52-4:15). This additional wager amount beyond the based wager amount is equivocated the claimed "side wager" and following therefrom allowing the player to vary the size of their wager is equivocated to presenting the player an option to be eligible for a special payout. Responsive to the presence of this "side wager" the player is eligible to receive a special progressive jackpot payout consisting of first payout/award equal to half of a progressive jackpot and a second

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payout/award equal to a percentage of the remaining portion of the jackpot that is in turn distributed among the remaining eligible players who did not receive the first payout upon awarding of the jackpot prize (Col 3::58-62 & 3:44-47).

Claims 2, and 27: In addition to the above, Celona teaches the incorporation of a third payout based on the randomly selected game outcome as a conventional game payout (Col 4:35-40) and alternatively as a local jackpot payout (Col 4:40-42).

Claims 5-7, and 16-18: In addition to the above, Celona teaches that the game machine may be of a slot type and a poker type wherein both machine types are understood to inherently contain a plurality of symbols (e.g. cards and slot machine wheel symbols) and further that a slot machine game inherently includes slot machine reel symbols while a poker game inherently includes card symbols for a deck of playing cards (Col 1:17-20, 6:28-33).

Claim 11: In further addition to the above, Celona teaches an awarding step cited in the redress of at least claim 1 above is performed by the controller located in the gaming terminal through the dispensing of an award amount (Col 4:48-56, Elm 342 Col 6:45-50).

Claim 15: In further addition to the above, Celona teaches the use of a button for initiating play of the gaming machine upon the deposit of a wager (Col 4: 16-20, 4:29-34). As the player must activate the button in order to commence play the side wager device of Celona is understood to incorporate a button.

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Claim 19: In further addition to the above, Celona teaches the incorporation of a plurality of gaming terminals wherein each terminal incorporates the side wager input device (Figure 1).

Claims 20-22: In further addition to the above, Celona teaches the incorporation of signage displaying the special jackpot payout, wherein the signage is located above, and coupled to the plurality of gaming device through a signage controller and terminal controllers. The signage and signage controller are further configured to receive a signal that at least one of a plurality of gaming machines is eligible to receive the special jackpot payout (Elm 308, 338 Col 6:51-7:51, 8:42-50, 9:1-3, Figure 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claim **23** is rejected under 35 U.S.C. 103(a) as being unpatentable over Celona (US 5,564,700).

Celona teaches the claimed invention as set forth above and including multiple gaming machines (Figures 1-3) however, is silent regarding explicitly teaching that the plurality of gaming machine utilized are identical gaming machines. The Examiner gives official notice that the utilization of identical gaming machines in a pari-mutuel jackpot system such as taught by Celona is exceptionally old and well known in the art. It therefore would have been prima facie obvious to have utilized the system of Celona with a plurality of identical gaming machine in order to promote the use of a particular gaming machine over comparative non-pari-mutuel jackpot systems.

Claims **4, 9-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Celona (US 5,564,700) as applied to at least claim **1** above, and further in view of Cannon (US 6,800,026).

Claims **4**: Celona teaches the claimed invention as set forth above however, is silent regarding award a bonus game as a special payout. In a related invention Cannon teaches awarding bonus games conditioned on placement of a max bet (*Cannon* Col 8:62-66). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the bonus game as a prize outcome in the game of Celona in order to provide an award outcome that would allow a plurality of participants to interact in a competitive environment (*Cannon* Col 2:41-44).

Claim **9-10**: Celona teaches the claimed invention as set forth above however is silent regarding slot machines including a plurality of paylines and requiring all of these pay

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lines to be utilized by the player to qualify for a bonus round, however the reference Cannon teaches this feature (*Cannon* Col 8:62-66). It would have been obvious to one of ordinary skill in the art to have utilized slot machines with a plurality of paylines and requiring all of these pay lines to be utilized by the player to qualify for a bonus round to increase the size of the maximum wager while additionally increasing the player's ability to achieve a positive outcome in the base game.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

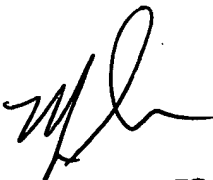
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RM

RM

March 26th, 2007



MARK SAGER
PRIMARY EXAMINER